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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,747	11/12/2003	Stephen F. Hatfield	HENK-0032	7528
38857	7590	12/28/2004		
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE, 46TH FLOOR PHILADELPHIA, PA 19103			EXAMINER RAYFORD, SANDRA M	
			ART UNIT 1772	PAPER NUMBER
DATE MAILED: 12/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,747	<b>Applicant(s)</b> HATFIELD, STEPHEN F. 	
	<b>Examiner</b> Sandra M. Nolan	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-18-04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claims*

1. Claims 1-22 are pending. The independent claims can be summarized as follows:
2. Claim 1 covers hot melt pressure sensitive adhesives (HMPSA's) comprising:
  - 10-50% of 1+ polymers,
  - 5-50% isoparaffinic oil, and
  - 30-65% of 1+ tackifier.
3. Claim 11 covers a hot melt construction adhesive comprising:
  - 5-20% linear styrene-butadiene A(BA)<sub>2</sub> multiblock polymer containing 25+ wt% styrene,
  - 5 to 20% linear styrene-isoprene ABA triblock polymer containing 25+ wt% styrene,
  - 40 to 65 wt% of 1+ tackifying resins,
  - 10 to 30 wt% isoparaffinic oil,
  - up to 10 wt% of 1+ waxes, and
  - up to 2 wt% of 1+ stabilizer,wherein the adhesive has a viscosity of 6,000 mPa's or less at 140°C, a shear adhesion failure temperature of 65°C and a 23 °C static shear time to failure of 25 hours or more.
4. Claim 13 covers an article comprising a plurality of components, at least two of which are adhered together with a HMPSA comprising:
  - 10-50 wt% of 1+ polymers,

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5-50 wt% isoparaffinic oil, and

30-65 wt% of 1+ tackifier.

5. Claim 22 covers an article comprising a plurality of components, at least two of which are adhered together with a HMPA comprising:

20 to 60 wt% of 1+ amorphous PP, APAO, PE or metallocene-catalyzed PE,

20 to 50 wt% of 1+ tackifying resin,

5 to 30 wt% of 1+ oils comprising 1+ isoparaffinic oil,

up to 2 wt% of 1+ stabilizers other than TNPP, and

up to 20 wt% of 1+ wax or filler.

***Information Disclosure Statement***

6. The information disclosure statement (IDS) submitted on 18 August 2004 was considered by the examiner.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What do the terms "APAO" and "YNPP" mean?

How do the PE and metallocene-catalyzed PE differ?

Please clarify the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3, 5-9, and 11-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Paul (US 6,448,303).

Paul teaches HMPA's (col. 1, line 37) containing 1 to 20% rubber triblock or radial block copolymer, 0-20% diblock rubber, 0 to 10% high MW polymer, 0 to less than 60 % oil and 0 to 50% tackifier (claim 2 of patent), up to 3% stabilizing antioxidants, such as hindered phenols (col. 5, lines 16-26) and 0 to 5% polyethylene wax (col. 5, lines 12-15).

The triblock or radial block copolymer is styrene –(ethylene-butylene)-styrene (claim 6 of the patent). The diblock is styrene-(ethylene-propylene) copolymer (claim 9 of the patent).

The oil is an isoparaffin (col. 4, line 11). The tackifiers are pentaerythritol esters of rosins, copolymers and terpolymers of terpenes or hydrogenated hydrocarbons/-copolymers (col. 4, lines 17-53).

The uses to which the adhesives are put do not distinguish the compositions claimed from those of Paul.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul.

Paul is discussed above. It fails to teach the oil of claim 10.

In the absence of convincing objective evidence to the contrary, it would have been obvious to one having ordinary skill in the art to employ the oil of claim 10 in the adhesives of Paul in order to plasticize them.

The selection of any suitable plasticizing additives is deemed a matter of engineering choice, depending upon the properties desired in the product.

14. Claims 1-9 and 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatfield et al (US 6,184,285) in view of Paul.

Hatfield teaches HMPA's for sanitary napkins (abstract) that contain 5 to 15% A-(BA)<sub>2</sub> multi-block copolymer having 35 to 45% styrene in it, 5 to 15% styrene-

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isoprene triblock copolymer having 35 to 45% styrene, 40 to 70% tackifying resin, 10 to 30% paraffin oil, 0 to 10 % polyethylene wax, and 0.25 to 2 % stabilizer (claim 18 of the patent). The adhesives have the viscosity, shear adhesion and static shear time features of claim 11 (claim 18 of the patent).

It fails to teach that the oils are isoparaffinic.

Paul shows paraffinic and isoparaffinic oils as plasticizers in HMPSA's (col. 4, lines 8-12).

The patents are analogous because they both deal with HMPSA's.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the isoparaffinic oils of Paul in the HMPSA's of Hatfield in order to plasticize them.

The motivation to employ the isoparaffinic oils of Paul in the HMPSA's of Hatfield is found at col. 4, lines 8-12 of Paul, where the isoparaffinic oils are said to be plasticizers for its HMPSA's.

Use of the HMPSA's suggested by the combination of Hatfield and Paul in various articles requiring the adhesion of surfaces to each other is deemed a matter of design/engineering choice, depending upon the adhesive properties desired.

### ***Double Patenting***

15. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

16. Claims 1-22 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 7-28 of copending Application No. 10/990,728. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 4-12 and 14-17 of copending Application No. 10/093,616 in view of Paul. Although the conflicting claims are not identical, they are not patentably distinct from each other because the isoparaffinic oil, that the '616 claims do not recite is shown to be a known plasticizer in Paul. See the discussion of Paul above.



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It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the isoparaffinic oil of Paul in the HMPA's of the '616 application in order to plasticize them.

The motivation to employ Paul's oils in the HMPA's of the '616 application is found at col. 4, lines 8-12 of Paul, where the isoparaffinic oils are said to be plasticizers for its HMPA's.

It is deemed desirable to plasticize HMPA's in order to facilitate their processing.

Use of the adhesives suggested by the combined teachings to bind various surfaces is deemed a matter of design/engineering choice, depending upon the adhesive properties desired.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/384810 in view of Paul.

The '810 application claims HMPA's having all of the claimed features except isoparaffinic oils.

Paul is discussed above.

The references are analogous because they both deal with HMPA's.

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It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the isoparaffinic oil of Paul in the HMPA's of the '810 application in order to plasticize them.

The motivation to employ Paul's oils in the HMPA's of the '810 application is found at col. 4, lines 8-12 of Paul, where the isoparaffinic oils are said to be plasticizers for its HMPA's.

It is deemed desirable to plasticize HMPA's in order to facilitate their processing.

This is a provisional obviousness-type double patenting rejection.

20. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,184,285 (to Hatfield) in view of Paul.

Claim 18 of Hatfield is discussed above. It fails to teach isoparaffinic oils.

Paul is discussed above.

The patents are analogous because they both deal with HMPA's.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the oils of Paul in the HMPA's of Hatfield to plasticize them.

The motivation to employ Paul's oils in the HMPA's of Hatfield is found at col. 4, lines 8-12 of Paul, where the isoparaffinic oils are said to be plasticizers for its HMPA's.

It is deemed desirable to plasticize HMPA's in order to facilitate their processing.


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**Conclusion**

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

  
S. M. Nolan-Rayford  
Primary Examiner  
Technology Center 1700

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